

## **REMARKS**

### **Status of the Claims**

Claims 10 and 11 are currently pending in the application. Claims 1-9 stand rejected. Claims 1-9 have been cancelled without prejudice or disclaimer. New claims 10 and 11 have been added. No new matter has been added by way of the present amendments. Specifically, new claim 10 is supported by the specification at, for instance, Formulation Example 3 at pages 16-17, page 4, lines 6-12, page 5, lines 8-9, and page 8, lines 2-3. Additionally, no new issues are presented by way of the present submission. For instance, claims 10 and 11 find support in previously pending and examined claims 1-4 and 6. In the event that the present submission does not place the application into condition for allowance, entry thereof is respectfully requested as placing the application into a better form for appeal. Reconsideration is respectfully requested.

### **Rejections Under 35 U.S.C. § 102(b)**

Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tomokazu et al., JP 08/217723 (hereinafter referred to as "Tomokazu et al."). (*See*, Office Action of March 25, 2008, at pages 2-3, hereinafter, "Office Action"). It is noted that although the Office Action only rejections claims 1-3 at page 2, it is presumed that the Examiner actually meant to reject all of the pending claims 1-9, since the Office Action Summary states that all pending claims are rejected. Clarification is requested in the next communication from the Office. Claims 1-3 have been cancelled herein without prejudice or disclaimer, thus obviating the present rejection. However, in an effort to be fully responsive to the Office Action, Applicants provide the

following comments concerning the distinguishing features of the presently claimed invention, as compared to Tomokazu et al.

The Examiner states that Tomokazu et al. disclose branched fatty acids, a polymerization degree of from 2 to 18, and an esterification degree range of from 60 to 90%. (*Id.* at page 2). The Examiner particularly points to paragraphs [0006]-[0011] of Tomokazu et al.

Further, the Examiner states that the Declaration filed December 21, 2007 was considered but was unpersuasive. The Examiner states that the Declaration merely resubmits data already present in the specification. The Examiner emphasizes that the rejection is based on the entirety of the disclosure of Tomokazu et al., not just the examples disclosed therein. Finally, the Examiner states that arguments based on inherent properties of the claimed compositions are unpersuasive.

The fatty acid ester of polyglycerol encompassed by claim 1 of Tomokazu et al. is produced by esterification of a polyglycerol and a fatty acid, wherein an alkaline catalyst is used in an amount of 0.06-0.25 mole % based on the fatty acid.

Tomokazu et al., at paragraph [0008], disclose that the reason for limiting the amount of alkaline catalyst to the above range is that if the amount of the alkaline catalyst is too high, the emulsifying capacity of the disclosed fatty acid ester of polyglycerol is depressed.

Tomokazu et al., at paragraph [0021], also disclose that the fatty acid ester of polyglycerol produced according to the method disclosed therein functions very well as a surfactant and is useful as a cleaner or emulsifier.

Therefore, the fatty acid esters of polyglycerol disclosed in Tomokazu et al. are intended to be used as surfactants or emulsifiers, which therefore means they should be used in a system containing both water and oil.

Tomokazu et al., at paragraph [0002], discloses that (known) fatty acid esters of polyglycerol have been used as a cosmetic. However, one of ordinary skill in the art would reason that since the fatty acid esters of polyglycerol disclosed in Tomokazu et al. are those used in a system containing both water and oil, as disclosed at paragraph [0002], and that therefore the cosmetics disclosed therein are cosmetics which contains both water and oil.

However, in contrast, lipsticks, according to the presently claimed invention, contain only oily material and do not contain water, as disclosed in "Formulation Example 3" at pages 16-17 of the present specification. Therefore, the cosmetics disclosed in Tomokazu et al. do not include a lipstick containing only oily material.

Thus, the presently claimed invention according to claims 10 and 11, encompassing a lipstick, is not disclosed in Tomokazu et al. Tomokazu et al. do not disclose all of the limitations of the presently claimed invention. Anticipation requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (*See, In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1990), quoting *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)).

Furthermore, the fatty acid ester of polyglycerol of the presently claimed invention imparts a water-retention property or a moisture retention property to lipstick. (*See*, the present specification, at page 5, last line, to page 6, lines 1-3). Although Tomokazu et al., and other

previously cited prior art, suggest that such fatty acid esters of polyglycerol can be used as a surfactant or an emulsifier, and to be used for a cosmetic containing both water and oil, none of these references disclose or suggest the concept of including the fatty acid esters of polyglycerol in a system containing only oily material, such as in a lipstick. The function of a surfactant or an emulsifier in a system containing both water and oil is quite different from the function of water-holding property and moisture retention property in a system containing only oily material. Thus, such references directed to applications including water and oil would be inapplicable to the presently claimed invention directed to a lipstick which contains no water.

Additionally, the Table provided below shows the Mole Ratio of the alkaline catalyst (NaOH) and the fatty acid as disclosed in the Examples of the present specification. The amount of the fatty acid used in the Examples of the present specification, and the mole ratio of the alkaline catalyst (NaOH) and the fatty acid are as follows:

Example No.	the fatty acid used in Examples	Molecular weight of the fatty acid (A)	Used amount of the fatty acid (g) (B)	Used amount of the fatty acid (mol) (C)	Mole Ratio of NaOH and fatty acid (D)
1	Isostearic acid	284	337	1.19	0.42
2	Octylic acid	144	150	1.04	0.48
3	Isostearic acid	284	351	1.24	0.41
4		284	337	1.19	0.42
5		284	360	1.27	0.39
6		284	405	1.43	0.35
7		284	450	1.58	0.32

In the above Table, (C) = (B)/(A), and (D) = 0.005\*100/(C), and 0.005 = Mole amount of NaOH. In all Examples in the present specification, the amount of the alkaline catalyst (NaOH) is 0.2g, which is 0.005 mol (since the molecular weight of NaOH is 40 g/mol).

As apparent from the Table, the Mole Ratio varies from 0.32% to 0.48%, which is much larger than the range of 0.06-0.25 mole %, the Mole Ratio of the alkaline catalyst and the fatty acid in Tomokazu et al.

Since the fatty acid ester of polyglycerol in the present specification is to be used for imparting to cosmetics a moisture retention property, while the fatty acid ester of polyglycerol compositions disclosed in Tomokazu et al. are intended to be used as surfactants or emulsifiers and for imparting emulsification properties to solutions, the ranges of the amount of the fatty acid ester of polyglycerol to be used are much lower than the ranges of amounts utilized in the present invention.

### CONCLUSION

If the Examiner has any questions or comments, please contact Thomas J. Siepmann, Ph.D., Registration No 57,374, at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

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Respectfully submitted,

By



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